

### **Claim Rejections Under 35 U.S.C. § 112**

Claims 8, 18, 22 were rejected by the PTO under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically claim 8 was objected to because the term "derivative" was unclear as to whether it referred to polycarboxylic acid or to dicarboxylic acid or to both terms. Applicants have amended claim 8 such that the term "derivative" now refers to both classes of acids and their combinations. Claim 8 was objected to by the PTO as being unclear regarding the Roman Numeral II and claim 22 is objected to as being unclear regarding the Roman Numeral recited within that claim. Applicants have amended both claims 8 and 22 to remove the references to the Roman Numerals.

### **Claim Rejections Under 35 U.S.C. § 103**

The PTO has rejected claims 1-23, 25 and 26 as being unpatentable under 35 U.S.C. § 103(a) over WO 96/15203 ('203) in view of JP-07-11755 ('755). The '203 reference is said by the PTO to describe a multilayer planar structure with a support member and a coating on a reinforced material. The '203 reference is acknowledged by the PTO as being directed to a textile and not a non-woven as is claimed in the present application. Furthermore, this reference is acknowledged as being silent in regards to the claim limitation of embedding or impregnating on a weight percent basis.

The combined teachings of the '203 reference and the '755 reference are said to render obvious the claimed invention of the present application. The '755 reference is said by the PTO to teach a flooring material having a surface layer comprising a fiber pile implanted with a synthetic resin. The implanted fiber pile is said by the PTO to be like a non-woven material which is impregnated. In regards to the claim limitation of embedding or

impregnating on a weight percent basis, the PTO stated that such a determination would have been routine optimization since it would have been obvious to one of ordinary skill in the art to appropriately select that range of basis weight to achieve flexibility. The motivation for combining the cited references was said by the PTO to be the expectation that the multilayer planar structure would exhibit improved properties of resilience with lower cost.

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *Burlington Indus., Inc. v. Quigg*, 822 F.2d 1581, 1584, 3 U.S.P.Q.2d 1436, 1439 (Fed. Cir. 1987). Initially, the PTO bears the burden of establishing the *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). To establish a *prima facie* case, the PTO must satisfy three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgem, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209, 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art reference or combination of references must teach or suggest all the limitations of the claims. See *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). To support a conclusion of obviousness, "either the references must expressly or impliedly suggest the claimed combination or the [PTO] must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). In evaluating obviousness, the Federal Circuit made it very clear that one must look to see if "the prior art would have suggested to one of ordinary skill in the art that this

process should be carried out and would have had a reasonable likelihood of success viewed in light of the prior art." *In re Dow Chemical Co. v. American Cyanamid Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.*

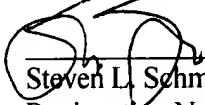
Applicants respectfully assert that the combined cited references do not teach or suggest that which is claimed in the present application. The present application claims a reinforcement material completely surrounded by a coating compound constituting the cover layer. Neither the '203 reference nor the '755 reference discloses or suggests a reinforcement material, which is completely surrounded by the coating compound constituting the cover layer. The covering compound in both references only covers the top portion of the material underlying the cover layer. Furthermore, neither reference teaches nor suggests a reinforcement non-woven material with a weight in the range from 9 to 50 g/m<sup>2</sup>.

Furthermore, the PTO has failed to cite any reference or motivation that would suggest the combination of these two references. The '203 reference is directed to a textile instead of a non-woven and fails to teach the embedding or impregnation on a weight basis. The '755 is directed to carpet tiles. One skilled in the art would not combine the two references since there is no suggestion within the art that such a combination would result in greater flexibility and reduced cost. The two references are clearly directed to two different products. The non-woven material cited in the Official Action as being taught in the '755 reference is a carpet tile surface. [0002]. The '203 reference is directed to a flat structure made of renewable raw materials. One skilled in the art would not combine the teachings of the two references as suggested by the PTO since neither reference teaches nor suggests increased flexibility by the combination of such art as prospected by the PTO.

Thus, Applicants respectfully submit that claims 1-23, 25 and 26 of the application are believed to be in a condition for allowance and an early notice to such effect is earnestly solicited.

6/10/02  
Date

Respectfully submitted,

  
Steven L. Schmid  
Registration No. 39,358

WOMBLE CARLYLE SANDRIDGE & RICE  
P. O. Box 7037  
Atlanta, Georgia 30357-0037  
(404) 962-7539 (Telephone)  
(404) 870-8234 (Facsimile)

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Cheryl West

## APPENDIX

8. (Twice Amended) The flat material according to claim 6, wherein the coating compound for the cover layer is a material containing polyreaction products, whereby the polyreaction products can be obtained by the reaction of at least one dicarboxylic acid, [or] polycarboxylic acid or their derivatives [or a mixture] and mixtures [of these] thereof with at least one epoxidation product of a carboxylic acid ester or a mixture of these epoxidation products.

18. (Twice Amended) The flat material according to claim 1, wherein the cover layer [(II)] is transparent.

22. (Twice Amended) The flat material according to claim 1, further comprising at least one carrier layer [(I)] and at least one previously defined cover layer [(II)], possibly one backing coating [(III)] located under the carrier layer [(I)] made of a chemically or mechanically foamed foam layer, and possibly a compact or base coating [(IV)], which is positioned between the carrier layer [(I)] and cover layer [(II)] and/or between the carrier layer [(I)] and backing coating [(III)], whereby the coating compounds for the layers [(III)] and [(IV)] are based on a material according to claim 6].

23. (Twice Amended) The flat material according to claim 22, wherein a protective layer [(VI)] of unsaturated curable lacquer systems is located over the cover layer [(II)], whereby the polymers or copolymers for the lacquer systems are selected from the group consisting of polyacrylates, polymethacrylates, polyurethanes, and mixtures of these.